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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,493	04/19/2004	John Temple	MMC-10902/29	3298
25006	7590	03/17/2006		
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			EXAMINER KASZTEJNA, MATTHEW JOHN	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/827,493	Applicant(s) TEMPLE, JOHN	
	Examiner Matthew J. Kasztejna	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the appeal brief filed on December 27, 2005, the finality of the rejection of the last Office action is withdrawn. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 1 recites, "one or more elongate partitions running lengthwise along the pad to establish fold line, each partition including a gap to facilitate fluid transfer of the mixture." The current specification fails to disclose partitions including a gap and partitions provided to facilitate fluid transfer of the mixture. The current specification discloses only to use partitions to establish fold areas for easier placement of the pad into a housing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,910,106 to Morgan et al.

In regards to claim 1, Morgan et al. disclose a system for warming an endoscope, laparoscope, or other such instrument to minimize fogging, comprising: a flexible pad 21 having a length, a width and a periphery for wrapping around the instrument, the pad including a mixture of water and sodium acetate to generate heat through an exothermic reaction (see Col. 4, Lines 52-62), an activation disc 41 located around the periphery of the pad and one or more elongate partitions running lengthwise along the pad to establish fold line, each partition including a gap to facilitate fluid transfer of the mixture (see Figs 2-3).

In regards to claim 2, Morgan et al. disclose a system for warming an endoscope, wherein the activation disc 41 is made of perforated stainless steel (see Col. 5, Lines 5-35).

In regards to claim 4, Morgan et al. disclose a system for warming an endoscope, further including a heat-conductive tube to receive the instrument around which the pad is wrapped (see Figs. 2-3).

Claim Rejections - 35 USC § 103

It is the examiner's position that, as broadly as claimed, Morgan clearly discloses one or more elongate partitions running along the pad to establish fold lines and wherein each partition includes a gap which inherently helps facilitate fluid transfer of the mixture. Applicant is advised that even if the argument is made that Morgan does not show all the features of recited claim 1, the following rejection under 103(a) still stands.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910,106) in view of Meckstroth (U.S. Patent No. 5,651,757).

In regard to claims 1, 2 and 4, Morgan et al. teach an instrument heater 21, such as for an optical scope 1, comprised of a sheath 23 having an inner wall 25 and an outer wall 27 where between the inner wall 25 and outer wall 7 is a chemical solution used in forming an exothermic reaction, such as sodium acetate and water (see Figures 1-3 and col. 4, lines 52-55). Between the inner wall 25 and the outer wall 27 at the tip 31 of sheath 23 is an activator disk 41 made form a flexible metal article with a plurality of slits, where flexing of the activator disk 41 released mixture particles of metal and causes a destabilization

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of the chemical solution to produce heat (see col. 5, lines 5-35 and Figure 3).

With further respect to claim 1, Morgan et al. are silent as to the sheath 23 being partitioned. However, Meckstroth discloses a similar endoscope warmer 10 comprised of a holster having a plurality of channels 22 through which a heated fluid circulates (see Figure 1). Meckstroth thus demonstrates that an endoscope warmer having partitions for more effectively circulating the warming fluid are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the sheath 23 of Morgan et al. with partitions, in the manner disclosed by Meckstroth, to ensure even distribution of the chemical mixture throughout the pad and thus even heat distribution..

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (U.S. Patent No. 5,910, 106) in view of Meckstroth (U.S. Patent No. 5,652,757), and further in view of Beane et al. (U.S. Patent Application Publication No. 2002/0022762).

In regard to claim 3, Morgan et al. are silent as to a housing to contain the sheath 23. However, Beane et al. disclose a similar warming device for an endoscope 10 where the device 10 has a housing 112 that contains a heating pad 120 into which the endoscope 10 is inserted (see Figure 2A). Beane et al. thus demonstrate that housing for containing a device to heat the insertion tube of an endoscope are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to

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provide the instrument heater 21 of Morgan et al. with a housing to contain the sheath 23.

Response to Arguments

Applicant's arguments filed December 27, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

It is the examiner's position that, as broadly as claimed, Morgan discloses one or more elongate partitions running along the pad to establish fold lines and wherein each partition includes a gap which inherently helps facilitate fluid transfer of the mixture. As seen in figure 2, partitions run lengthwise along the sheath and thus create a folded area. Furthermore, each partition includes a gap area which inherently facilitates fluid transfer as seen in the cross-sectional view of figure 2.

Applicant's arguments with respect to claims 1, 2 and 4 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK *mt*

3/13/06



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